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DELAND LAW OFFICE P.O. BOX 69 KLAMATH RIVER, CA 96050-0069			WILLIAMS, THOMAS J	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KANJI KIRIMOTO, TSUYOSHI SAKASHITA
and KAZUHISA YAMASHITA

Appeal 2009-002559
Application 10/826,173
to reissue Patent 6,557,671
Technology Center 3600

Decided: November 6, 2009

Before: ALLEN R. MacDONALD, *Vice Chief Administrative Patent Judge*,
FRED E. McKELVEY, *Senior Administrative Patent Judge*, and HOWARD
B. BLANKENSHIP, *Administrative Patent Judge*.

McKELVEY, *Senior Administrative Patent Judge*.

DECISION ON REHEARING

1 A. Statement of the case

2 Shimano requests rehearing of our decision mailed 17 August 2009.

3 The rehearing request was filed on 16 October 2009 and therefore is
4 timely.

5 The rehearing request is limited to claims 72 and 73.

6 We note that the rehearing request does not identify the appeal
7 number in the heading. In the future, counsel should add the appeal number
8 to any paper filed during the pendency of an appeal.

1 In our decision we indicated that the arguments with respect to claims
2 72-73 appear to be the same as the argument with respect to claim 37.

3 Since we affirmed a prior art rejection of claim 37, it was our view
4 that claims 72-73 fell with claim 37.

5 In the rehearing request, Shimano suggests otherwise.

6 We agree that limitations in claims 72-73 and not present in claim 37
7 were separately argued in the Appeal Brief.

8 We believe the separate arguments are entitled to a consideration on
9 the merits.

10 B. Claim 72

11 Claim 72 calls for a caliper housing which "is not adjustable *at any*
12 *time* relative to the surface of the caliper housing . . ." (italics added).

13 According to Shimano, the language "at any time" patentably
14 distinguishes claim 72 from Le Deit. We disagree.

15 The Examiner found that the bracket has a single position relative to
16 the housing "at any time after assembly." Examiner's Answer, page 8.

17 The language "at any time" appears once in the specification
18 (col. 9:42-45): "[p]referably, the lengths of the guide pin 90c and the blind
19 bore 91c are such that they do not disengage *at any time* during the axial
20 movement of the output cam 91 relative to the input cam 90." (Italics
21 added).

22 During examination (including examination of an application to
23 reissue), we give a claim its broadest reasonable interpretation consistent
24 with the specification. *In re Prater*, 56 CCPA 1381, 1395-96, 415 F.2d

1 1393, 1404-05 (CCPA 1969); *In re Reuter*, 670 F.2d 1015, 1019 (CCPA
2 1981).

3 The claim on appeal covers a device which has been assembled.

4 Once assembled, the Le Deit device is not adjustable any time
5 thereafter. That is the whole point of elements 68 and 70 as shown in
6 Le Deit Fig. 6 and discussed at col. 5:13-20. Compare Fig. 2 without
7 corresponding elements 68 and 70 which would be adjustable after
8 assembly.

9 The Examiner's interpretation of "at any time" in claim 72 is
10 consistent with a use of "at any time" which appears in the specification.

11 The Examiner's finding that Le Deit describes elements not adjustable
12 after assembly has not been shown to be erroneous.

13 Shimano, on the other hand, invites us to read limitations (not
14 described *in haec verba* in the specification) into the claim. We decline the
15 invitation and affirm the Examiner rejection of claim 72 over the prior art.

16 C. Claim 73

17 Claim 73 calls for a cable support extending from a surface of a
18 caliper housing" and is not *removable* relative to the surface of the caliper
19 housing." (*Italics added*).

20 We have been unable to find the word "removable" in the Shimano
21 specification.

22 Shimano maintains—in effect—that Le Deit Fig. 6 elements 68 and
23 70 do not preclude removal (disassembly) of element 44 from element 66.

24 In other words, the Le Deit device can be assembled, unassembled
25 (removed) and reassembled. Element 44 can be removed from element 66.

Shimano corresponding Fig. 7 element 44 (coincidentally the same number as Le Deit element 44) is integral with element 42 and cannot be removed from element 42 absent destruction of the two combined elements.

The Examiner interpreted "removable" as never being removed after assembly. While the "after assembly" works for claim 72, it does not work for claim 73. The word "removable" means cannot be removed—cannot be disassembled and reassembled. Shimano element 44 cannot be removed in any practical way from Shimano element 42. The "corresponding" Le Deit Fig. elements can be removed one from the other and reassemble—not so with the Shimano device.

An element of claim 73 has not been shown to be described in the prior art. Accordingly, we reverse the prior art rejection of claim 73.

The feature in question was not claimed during original prosecution and appears in all respects to be material and overlooked.

Accordingly, the recapture rejection of claim 73 is also reversed.

D. Order and Summary of decisions on appeal after rehearing

Upon consideration of the appeal, and for the reasons given in the decision entered 17 August 2009, as well as those stated herein, it is

ORDERED that the rehearing request is *granted* to the extent indicated, but is otherwise *denied*.

1

2 FURTHER ORDERED that the decision of the Examiner
3 rejecting claims 43, 69-71 and 73-74 over the prior art is *reversed*.

4 FURTHER ORDERED that the decision of the Examiner
5 rejecting claims 37-42, 47-60 and 72 over the prior art is *affirmed*.

6 FURTHER ORDERED that the decision of the Examiner
7 rejecting claims 69-71 and 73-74 based on the recapture rule is *reversed*.

8 FURTHER ORDERED that the decision of the Examiner
9 rejecting claims 37-60 and 72 based on the recapture rule is *affirmed*.

10 FURTHER ORDERED that no further request for rehearing is
11 authorized.

12 FURTHER ORDERED that this rehearing decision is a final
13 agency action.

14 FURTHER ORDERED that no time period for taking any
15 subsequent action in connection with this appeal may be extended under
16 37 C.F.R. § 1.136(a)(1)(iv) (2009).

17 AFFIRMED-IN-PART and REVERSED-IN-PART

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yrt

19 cc (via First Class mail):

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